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10/723,243	11/26/2003	Brett Watson-Luke	500.829US1	6035
27530	7590	07/17/2006	EXAMINER	
NELSON MULLINS RILEY & SCARBOROUGH, LLP 1320 MAIN STREET, 17TH FLOOR COLUMBIA, SC 29201			MYINT, DENNIS Y	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/723,243

Applicant(s)

WATSON-LUKE ET AL.

Examiner

Dennis Myint

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05/15/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-43 have been examined.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6, 13-15, and 20-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.2.(b)** states that “a claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts”.

***MPEP 2106.II.A states that “a process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994)”.***

Claims 1-6, 13-15, and 20-43 in view of the above-cited MPEP sections are not statutory because they merely recite a number of computing steps without producing any tangible results and/or being limited to practical application within the technological arts. The claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. **The use of a computer is not evident in the claim.** MPEP 2106.IV.B.1 (a) refers to “computer-readable” medium with computer program encoded

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on it."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 1-3, 6-9, 12-17, 20-22, 25-27, 30-33, and 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surasinghe (U.S. Patent Application Publication Number 2004/0194069) in view of Dorland (U.S. Patent Application Publication Number 2004/0221026).

As per claim 1, Surasinghe is directed a method which teaches the limitations:  
"receiving an input through a graphical user interface" (Figures 2A and 2B ;

Paragraphs 0030, i.e., *provides to a user one or more graphical user interfaces (GUIs) 20 that allows a user to view, create, and/or edit; and Paragraph 0031, i.e., The user selects a rule category of interest by clicking on one of the appropriate buttons 22-30.* Note that when user creates and edits, user input is inherent. );

“determining a data type, wherein the data type is associated with a set of configuration items” (Paragraph 0030, i.e., *the DBLRI 12 provides a user with GUI's that correspond to respective types of trading rules, for example, validation rules, matching rules, on-execution rules, post-match rules, closing action rules, and so forth. Further, as discussed in more detail below, the user may also view, create and edit user defined parameters or data objects that establish various trading instruments, various market types that define in which market a user may operate, and so forth.; and Paragraph 0031, i.e., The user selects a rule category of interest by **clicking on** one of the appropriate buttons 22-30. In the example, the user selects validation rules by clicking on button 24. Note that by way of click-ons (inputs), the method of Surasinghe determines data type which is associated with a set of configuration items (types of trading rules). ),*

and “wherein the configuration items correspond to configuration data stored in an operation support system” (Figure 1: *Data Base 16* and Paragraph 0028, i.e., *the database using dynamic schema that link the*

*fields and sub-fields to the various types or categories of rules, as discussed in more detail below.);*

“selecting an operation based on the configuration item data type, wherein the operation is associated with the input” (Paragraph 0031, i.e., *The user selects a rule category of interest by **clicking on** one of the appropriate buttons 22-30.);* and

“performing the operation” (Paragraph 0032).

Surasinghe does not explicitly teach the limitation: “wherein each of the configuration items is represented in a markup language”.

Dorland teaches the limitation:

“wherein each of the configuration items is represented in a markup language”(Paragraphs 0041, i.e., *The configuration file or configuration information for the e-integration manager can be in XML.)..*

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the feature of using a markup language such as XML for configuration file, as taught by Dorland, to the method of Surasinghe so that, in the resultant method, each of the configuration items will be represented in a markup language. One would have been motivated to do so because XML is **a common data format** and can be forwarded to another entity (e.g., can be used to exchange information with, or transfer information to, another e-manager or an e-manager integration manager) or stored, for example in the data storage of the e-manager (Dorland, Paragraph 0021).

Referring to claim 2, Surasinghe in view of Dorland teaches the limitation:

“wherein the each of the configuration items is stored in a separate configuration item file” (Dorland, Paragraph 0022 and 0041, i.e., *listings of XML codes of configuration files* and Surasinghe, Paragraph 0028, i.e., *New fields and sub-fields are added to the database using dynamic that link the fields and sub-fields to the **various types or categories** of rules, as discussed in more detail below.* ).

Referring to claim 3, Dorland teaches the limitation:

“wherein the determining the data type is based on content of the at least one of the separate configuration item files, and wherein the determining is based on a markup language schema or an XPath expression” (Dorland, Paragraphs 0022 and 0041, *listings of XML codes of configuration files* and said listings discloses a markup language schema ).

Referring to claim 6, Surasinghe teaches the limitation.

“wherein the operation is one of a user-extendable set of operations associated with the data type” (Paragraph 0032, i.e., *However, the user may add new parameters, and write new rules or edit exiting rules by selectively incorporating various parameters, operators and functions.*).

Referring to claim 7, Surasinghe in view of Dorland is directed to a method and teaches the limitations:



“receiving a selection of a configuration item, wherein the configuration item is associated with a data type, and wherein the configuration item is represented in a markup language” (Surasinghe, Paragraph 0030 and Paragraph 0031 and Dorland Paragraphs 0041);

“selecting a first set of one or more operations from a second set of operations, wherein the selecting is based on the data type” (Surasinghe, Paragraph 0031, i.e., *The user selects a rule category of interest by **clicking on** one of the appropriate buttons 22-30*);

“presenting the first set of one or more operations” (Surasinghe, Paragraph 0030, i.e., *the DBLRI 12 provides a user with GUI's that correspond to respective types of trading rules*);

“receiving a selection of an operation of the first set the one or more operations” (Surasinghe, Paragraph 0031, i.e., *The user selects a rule category of interest by **clicking on** one of the appropriate buttons 22-30*); and

“performing the operation” (Surasinghe, Paragraph 0032).

Referring to claim 8, Surasinghe teaches the limitation:

“wherein the configuration item is stored in an operations support system”

(Surasinghe, Paragraph 0026-0027. Note that the system of Surasinghe is an operating support system.).

Referring to claim 9, Surasinghe in view of Dorland teaches the limitation:

“wherein the each of the configuration items is stored in a separate configuration item file” (Dorland, Paragraph 0022 and 0041, i.e., *listings of XML codes of configuration files* and Surasinghe, Paragraph 0028, i.e., *New fields and sub-fields are added to the database using dynamic that link the fields and sub-fields to the **various types or categories** of rules, as discussed in more detail below.* ).

Referring to claim 12, Surasinghe teaches the limitation.

“wherein the first set of operations is a user-extendable set” (Paragraph 0032, i.e., *However, the user may add new parameters, and write new rules or edit exiting rules by selectively incorporating various parameters, operators and functions.*).

Referring to claim 13, Surasinghe in view of Dorland is directed to a method and teaches the limitations:

“executing an interactive utility that is associated with a configuration item data

type wherein the executing includes” (Surasinghe , Figures 2A and 2B ; Paragraphs 0030, 0031, ),

“displaying a dialog box, wherein the dialog box includes one or more input fields” (Surasinghe, Figure 3);

“receiving data in one or more of the inputs fields” (Surasinghe, Figures 2A and 2B ; Paragraphs 0030); and

“inserting the data into a markup language representation of a configuration item, wherein the configuration item is of the configuration item data type” (Dorland, Paragraph 0022 and 0041, i.e., *The configuration file or configuration information for the e-integration manager can be in XML*).

Referring to claim 14, Surasinghe is directed to the limitation:

“wherein the interactive utility is on of a user-extendable set of interactive utilities” (Paragraph 0032, i.e., *However, the user may add new parameters, and write new rules or edit exiting rules by selectively incorporating various parameters, operators and functions.; and Paragraph 0030, i.e., provides to a user one ore more graphical user interfaces (GUIs) 20 that allows a use to view, create, and/or edit;*).

Referring to claim 15, Surasinghe teaches the limitation:

“wherein the configuration item data type is associated with a plurality of interactive utilities” (Paragraph 0030, i.e., *provides to a user one ore more graphical user interfaces (GUIs) 20 that allows a use to view, create, and/or edit.; and Paragraph 0032, i.e., However, the user may add new parameters, and write new rules or edit exiting rules by selectively incorporating various parameters, operators and functions.*).

Referring to claim 16, Surasinghe in view of Dorland is directed to a method and teaches the limitations:

“determining a data type associated with one or more configuration items, wherein the one or more configuration items include a first set of property values, and wherein the one or more configuration items are associated with configuration data stored in an operations support system” (Surasinghe, Paragraphs 0028, 0030, 0031 and Figures 2A and 2B);

“determining a second set of properties, wherein ones of the second set of properties are associated with the data type, and wherein ones of the second set of properties correspond with ones of the first set of property values” (Surasinghe, Paragraph 0030-0032);

“presenting a property sheet, wherein the property sheet includes certain ones of the set of properties, and wherein the property sheet includes input fields associated with certain ones of the first set of property values” (Surasinghe, Paragraph 0032, i.e., *However, the user may add new parameters, and write new rules or edit exiting rules by selectively incorporating various parameters, operators and functions.;* and Dorland, Paragraph 0022 and 0041);

“receiving data in the input fields” (Surasinghe, Figures 2A and 2B ; Paragraphs 0030); and

“modifying ones of the first set of property values based on the data” (Surasinghe, Paragraph 0032, i.e., *However, the user may add new parameters, and*

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*write new rules or edit exiting rules by selectively incorporating various parameters, operators and functions).*

Referring to claim 17, Surasinghe in view of Dorland teaches the limitation:

“wherein the second set of properties is a user-extendable set” (Surasinghe, Paragraph 0032, i.e., *However, the user may add new parameters, and write new rules or edit exiting rules by selectively incorporating various parameters, operators and functions.*; and Dorland, Paragraph 0022 and 0041, i.e., *listings of XML codes of configuration files*) Note that XML is extensible.

Claim 20 is rejected on the same basis as claim 1.

Claim 21 is rejected on the same basis as claim 2.

Claim 22 is rejected on the same basis as claim 3.

Claim 25 is rejected on the same basis as claim 1.

Claim 26 is rejected on the same basis as claim 2.

Claim 27 is rejected on the same basis as claim 3.

Claim 30 is rejected on the same basis as claim 6.

Claim 31 is rejected on the same basis as claim 7.

Claim 32 is rejected on the same basis as claim 8.

Claim 33 is rejected on the same basis as claim 9.

Claim 36 is rejected on the same basis as claim 12.

Claim 37 is rejected on the same basis as claim 13.

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Claim 38 is rejected on the same basis as claim 14.

Claim 39 is rejected on the same basis as claim 15.

Claim 40 is rejected on the same basis as claim 16.

Claim 41 is rejected on the same basis as claim 17.

6. Claim 4, 5, 10, 11, 18, 19, 23, 24, 28, 29, 34, 35, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surasinghe in view of Dorland and further in view of Rozek et al., (hereinafter "Rozek") (U.S. Patent Application Publication Number 2004/0205562).

Referring to claim 4, Surasinghe in view of Dorland does not explicitly teach the limitation: "wherein the data type is associated with a data type definition, wherein the data type definition is one of a user-extendable set of data type definitions".

Rozek teaches the limitation:

"wherein the data type is associated with a data type definition, wherein the data type definition is one of a user-extendable set of data type definitions" (Figure 7, Figure 8, and Paragraph 0026, i.e. *a data type definition (DTD)*). Note that all XML data type definitions are extensible.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add the feature of using data type definition, as taught by Rozek, to the method of Surasinghe in view of Dorland so that, in the resultant method, the data type is associated with a data type definition and the data type definition is one

of a user-extendable set of data type definitions. One would have been motivated to do so because XML data type definitions are notoriously well known in the art.

Referring to claim 5, Rozek teaches the limitation:

“wherein the data type definition is represented in a markup language” (Figure 7, Figure 8, and Paragraph 0026). Note that XML is a markup language.

Referring to claim 10, Rozek teaches the limitation:

“wherein the data type is associated with a data type definition, wherein the data type definition is one of a user-extendable set of data type definitions” (Figure 7, Figure 8, and Paragraph 0026, i.e. *a data type definition (DTD)*). Note that all XML data type definitions are extensible.

Referring to claim 11, Rozek teaches the limitation:

“wherein the data type definition is represented in a markup language” (Figure 7, Figure 8, and Paragraph 0026). Note that XML is a markup language.

Referring to claim 18, Rozek teaches the limitation:

“wherein the data type is associated with a data type definition, wherein the data type definition is one of a user-extendable set of data type definitions” (Figure 7, Figure 8, and Paragraph 0026, i.e. *a data type definition (DTD)*). Note that all XML data type definitions are extensible.

Referring to claim 19, Rozek teaches the limitation:

“wherein the data type definition is represented in a markup language” (Figure 7, Figure 8, and Paragraph 0026). Note that XML is a markup language.

Claim 23 is rejected on the same basis as claim 4.

Claim 24 is rejected on the same basis as claim 5.

Claim 28 is rejected on the same basis as claim 4.

Claim 29 is rejected on the same basis as claim 5.

Claim 34 is rejected on the same basis as claim 10.

Claim 35 is rejected on the same basis as claim 11.

Claim 42 is rejected on the same basis as claim 42.

Claim 43 is rejected on the same basis as claim 19.



### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows:

- (1) U.S. Patent Application Publication Number 2002/0026339 (Frankland et al.)
- (2) U.S. Patent Application Publication Number 2006/0059107 (Elmore et al.)
- (3) U.S. Patent Application Publication Number 2003/0135665 (Barker et al.)
- (4) U.S. Patent Number 6983317 (Bishop et al.)
- (5) U.S. Patent Number 5867494 (Krishnaswamy et al.)
- (6) U.S. Patent Application Publication Number 2003/0133552 (Pillai et al.)
- (7) U.S. Patent Application Publication Number 2001/0047279 (Gargone)
- (8) U.S. Patent Application Publication Number 2002/0184111 (Swanson)

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Myint whose telephone number is (571) 272-5629. The examiner can normally be reached on 8:30AM-5:30PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-5629.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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